

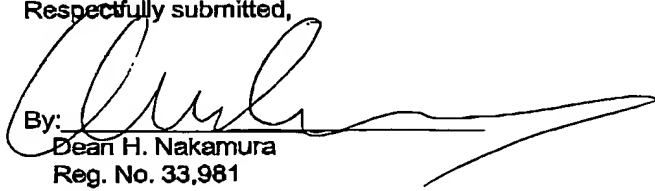
Reply to Office Action  
Serial No. 09/539,382

BOTH conditions apply to the instant divisional CPA.

In prolonged consultations with the Patent Office, the undersigned was directed to the above MPEP sections and told that the proper way to have new claims examined in expedited fashion was to file a divisional CPA with a Preliminary Amendment presenting the new claims.

Hence, the Preliminary Amendment is proper and early examination on the merits is requested respectfully.

Respectfully submitted,

By:   
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Reg. No. 33,981

Dated: 26 August 2002

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this Reply to Office Action (4 pages total) is being transmitted by facsimile to the United States Patent and Trademark Office, Fax. No. (703) 308-4242 on 26 August 2002.

  
Sharon Fitzgerald

## TYPES, CROSS-NOTING, AND STATUS OF APPLICATION

201.06(d)

**TERMINAL DISCLAIMER**

A terminal disclaimer filed in the parent application carries over to a CPA. The terminal disclaimer filed in the parent application carries over because the CPA retains the same application number as the parent application, i.e., the application number to which the previously filed terminal disclaimer is directed. If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under 37 CFR 1.182 along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over to the CPA. See MPEP § 1490, "Withdrawing a Terminal Disclaimer," subheading entitled "A. Before Issuance of Patent."

**PRIOR ELECTION**

An election made in the prior application carries over to the CPA only if all of the following conditions are met: (1) the CPA is designated as a continuation or is not designated at all (i.e., the CPA is NOT designated as a divisional); (2) there was an express election by the applicant in reply to a restriction requirement in the prior application; (3) the CPA presents claim(s) drawn only to invention(s) claimed in the prior application; and (4) the CPA does not contain an indication that a shift in election is desired.

Where all of the conditions are met, the examiner's first action should repeat the restriction requirement made in the prior application to the extent it is still applicable in the CPA and include a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application.

**INFORMATION DISCLOSURE STATEMENTS**

All information disclosure statements filed in the prior application that comply with the content requirements of 37 CFR 1.98 will be considered in a CPA by the examiner. No specific request that the previously submitted information be considered in a CPA is required.

In addition, all information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed within three months of the filing date of a CPA will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that

point in time. Thus, in the rare instance that a final Office action or a notice of allowance is prepared and mailed prior to a date which is 3 months from the filing date of the CPA, any information contained in an information disclosure statement complying with 37 CFR 1.98, and filed within that 3-month window must be considered by the examiner. Since a CPA requires less processing time than a file wrapper continuing application under former 37 CFR 1.62, it should be expected that a first Office action will normally issue in a CPA well within three months from the filing date of the CPA request. The submission of an information disclosure statement after the first Office action is mailed could delay prosecution and result in the loss of patent term. Therefore, applicants are encouraged to file any information disclosure statement in a CPA as early possible, preferably before the first Office action. For further discussion of information disclosure statements, see MPEP § 609.

**COPIES OF AFFIDAVITS**

Affidavits and declarations, such as those under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the parent nonprovisional application, automatically become a part of the CPA. Therefore, no copy of the original affidavit or declaration filed in the parent nonprovisional application need be filed in the CPA.

**FORMS**

Form PTO/SB/29, "Continued Prosecution Application (CPA) Request Transmittal" and Form PTO/SB/29A, "Receipt For Facsimile Transmitted CPA" may be used by applicant for filing a CPA under 37 CFR 1.53(d). The forms used by the patent examining groups to notify applicants of defects regarding applications filed under 37 CFR 1.53(d) are shown below. "Notice of Improper Application, No Filing Date Granted" Form PTO-2011; "Notice of Improper CPA Filing Under 37 CFR 1.53(d), No Filing Date Granted" Form PTO-2012; "Notice To File Missing Parts Of Application (CPA), Filing Date Granted" Form PTO-2021; "Notice Of Incomplete Reply (CPA) (Filing Date Granted)" Form PTO-2018; and "Notice Of Abandonment Under 37 CFR 1.53(f) (CPA) (Filing Date Granted)" Form PTO-2019.

818.03(d)

## MANUAL OF PATENT EXAMINING PROCEDURE

**818.03(d) Traverse of Nonallowance of Linking Claims**

A traverse of the nonallowance of the linking claims is not a traverse of the requirement to restrict; it is a traverse of a holding of nonallowance.

Election combined with a traverse of the nonallowance of the linking claims only is an agreement with the position taken by the Office that restriction is proper if the linking-type claim is not allowable and improper if they are allowable. If the Office allows such a claim, it is bound to withdraw the requirement and to act on all linked inventions. But once all linking claims are canceled 37 CFR 1.144 would not apply, since the record would be one of agreement as to the propriety of restriction.

Where, however, there is a traverse on the ground that there is some relationship (other than and in addition to the linking-type claim) that also prevents restriction, the merits of the requirement are contested and not admitted. Assume a particular situation of process of making and product made where the claim held linking is a claim to product limited by the process of making it. The traverse may set forth particular reasons justifying the conclusion that restriction is improper where the process necessarily makes the product and there is no other present known process by which the product can be made. If restriction is made final in spite of such traverse, the right to petition is preserved even though all linking claims are canceled.

**818.03(e) Applicant Must Make Own Election**

Applicant must make his or her own election. The examiner will not make the election for the applicant. 37 CFR 1.142, 37 CFR 1.143, second sentence.

**819 Office Generally Does Not Permit Shift**

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in MPEP § 821.03.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not

waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

Where an application filed under 37 CFR 1.53(d), a continued prosecution application (CPA), is a continuation and not a divisional, or where an application filed under former 37 CFR 1.62, File Wrapper Continuation (FWC), is a continuation and not a divisional or C-I-P, an express election made in the prior application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant. Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (1) a divisional or (2) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the examiner should make a new restriction requirement in the first action.

**819.01 Office May Waive Election and Permit Shift**

While applicant, as a matter of right, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift. It may do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues. *Ex parte Heritage*, Pat. No. 2,375,414 decided January 26, 1944. If the examiner has accepted a shift from claiming one invention to claiming another, the case is not abandoned. *Meden v. Curtis*, 1905 C.D.272, 117 O.G. 1795 (Comm'r Pat. 1905).

**820 Not an Election; Permissible Shift**

Where the Office rejects on the ground that the process is obvious, the only invention being in the product made, presenting claims to the product is not a shift. *Ex parte Trevette*, 1901 C.D. 170, 97 O.G. 1173 (Comm'r Pat. 1901).